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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,703	12/21/2000	Edward O. Clapper	42390P10477	9686

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TROP PRUNER & HU, PC
8554 KATY FREEWAY
SUITE 100
HOUSTON, TX 77024

EXAMINER

DEANE JR, WILLIAM J

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,703

Applicant(s)

CLAPPER, EDWARD O.

Examiner

William J Deane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-11,33,34,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4, 6-11, 33-34, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner did not find these limitations in the specification nor did applicant point out where such limitations could be found in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6 – 15 and 32 – 34, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 5,901,209 (Tannenbaum et al.).

With respect to claims 1 - 3, 6 – 15, and 32 – 34, such is clearly taught by Tannenbaum et al. at Col. 2, lines 34 – 67, Col. 3, lines 8 – 10, Col. 12, lines 6 – 36 and Col. 12, lines 42 - 61.

With respect to claim 1, the reference teaches receiving a communication to a called party at a specified destination (see Col. 12, lines 31 – 35). Note that the claimed “specified destination” could be either any called party specified by a phone number or

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the number to the system 10 (communication network). Such broad limitations could be rejected in this manner. Receiving a communication to a called party (the called party being system 10), at a specified destination (the phone number or access number to system 10) the communication having first identifying information and authorizing the user of the first communication device (see Col. 11, lines 12 – 20) and replacing the first identifying information with second identifying information Col. 12, lines 31 – 35 or Col. 12, lines 50 - 52). The first communication device can be 105 - 108, 114 – 115 in Fig. 1 or any phone used by a home agent or policeman etc. (see Col. 2, lines 34 – 44).

A different interpretation of Tannenbaum is that even if one must first call into system 10 using a first communication device and use a predictive dialer 110, system 10 receives communication to a called party at a specified destination (the phone number of called party), the communication having first identifying information and authorizing the user of the first communication device (see Col. 11, lines 12 – 20) and replacing the first identifying information with second identifying information (Col. 12, lines 50 – 52). This is even clearer when one understands that the user inputs the phone number of called parties into call management system (CMS) 109, see Col. 3, lines 15 – 23. That is, the call is for the called party, the call must first go through the CMS and predictive dialer 110, which is system 10. Note that a campaign (multiple calls) need not be utilized and that ID changes can be made for just one call (see Col. 12, lines 55 – 57). Therefore, if one access system 10 and inputs the number to be called, system 10 has received a communication to a called party. Whether the inputting of the phone number was done at an earlier time than the time the predictive

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dialer calls the called party is of no consequence. Note that in Applicant's device the call passes through a system 12 and router 40, while in Tannenbaum the call also goes through a system 10 and a router (predictive dialer) 110.

With respect to claim 3, note Col. 2, lines 55 – 57, Col. 3, lines 8 – 14, Col. 12, lines 31 – 35 and Col. 12, lines 42 – 58.

With respect to claim 6, note Col. 11, lines 11 – 20.

With respect to claim 7, note Col. 12, lines 50 – 52.

With respect to claim 8, note Col. 12, lines 10 – 16.

With respect to claim 9, note the rejections above, Fig. 1 and Col. 3, line 31.

With respect to claims 10 – 15, note the rejections above.

With respect to claim 32, note the rejections above. In addition, with respect to the router, note that the predictive dialer acts as a router. Additionally, note that the predictive dialer could include a call control algorithm and/or a telephone-switching algorithm. These are also routers.

With respect to claims 33 – 34 note database 601 and the above rejections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 36 – 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tannenbaum.

With respect to claim 4, note database 601 in Fig. 6. It is obvious and old in the art that a user is prompted in some fashion to populate the information in this database. Since the ID can be changed on a call by call basis one would have to be prompted, whether the user is prompted in real-time or set up at an earlier time, is of no consequence. It would have been obvious to one of ordinary art to use a prompting means wherever it was deemed necessary.

With respect to claims 36 – 37, such limitations would have been obvious to one of ordinary skill in the art in light of Tannenbaum if not already inherent.

Response to Argument

Claims 1, 3 - 4, 6 – 15 and 32 – 34 Are Not Patentable In View Of Tannenbaum

With respect to claims 1 – 2, for some reason, Applicant has decided that the first calling device is a predictive dialer. Then Applicant argues that since the predictive dialer calls the destination number and connects an agent into the call, the agent of Tannenbaum is not the user of the first communications device and therefore no user of the first communication device to authenticate. Applicant's interpretations of the reference are different from the examiner's.

Applicant has been asked to compare the example recited by Applicant at page 6, lines 11 – 16, of the instant application with the examples recited in Tannenbaum et al. at Col. 12, lines 6 – 36. Note that, with respect these passages in Tannenbaum, no predictive dialer is mentioned, only that the ID change occurs at a database. Even if the predictive dialer is used in this embodiment, it acts as a router analogous to Applicant's

communication router 40. Note also that Tannenbaum teaches that the system can be used for one call or for a campaign of calls. If one uses the system of Tannenbaum and only one person is to be called and since all the information is in the database 601, i.e., call ID, call Pseudo ID, Origination phone number and destination number then the predictive dial would just act as a router and pass the call to the second communications device. This is in particularly true in light of Col. 9, lines 13 – 16. That is, the predictive dialer could act just like a telephone switch or router exactly like Applicant's device. In other words, in Tannenbaum, one sends in the access code to the database along with the phone number (or prompted for the phone number) and the predictive dialer having the telephone switching capability would route the call to the intended called party.

The important thing to note is that even if Applicant is correct in what he is arguing, Applicant leaves out a vital point and that is, that the a predictive dialer does not act in a vacuum. Even if the predictive dialer is used (even without the telephone switching algorithm) in the embodiment at Col. 12, lines 6 – 61, the method of receiving a communication to a called party at a specified destination (phone number) from a first communication device having therewith first identifying information, reads on Tannenbaum. In Tannenbaum, the user of the first communication device calls into the system, authenticating the user of the first communication device (note use of special codes Col. 12, lines 31 – 36 and line 47 and 55 – 58) and then of course it replace the first ID with a second ID. Therefore, it is the first user who is using his first communication device that accesses system 10 and indicates what numbers are to be

called, even if the contacts were put in at an earlier time and the predictive dial calls the next day, system 10 of Tannenbaum received a communication to a called party. Note that Applicant does not argue that his system intercepts a call to a called party. All of this withstanding and even accepting Applicant's arguments as correct, the predictive dialer can act just like Applicants router because the predictive dialer can contain a call control algorithm and/or telephone switching algorithm (again see Col. 9, lines 13 – 16).

Applicant maybe arguing that in Tannenbaum the first user sets the phone numbers to be called and specifies what the caller ID is to be changed to and then hangs up. Next the predictive dialer will call the number and if the person called answers the phone the predictive dialer will call the caller back connecting the call. In other words, Applicant maybe arguing that his device works "on the fly". However, the claims do not recite any language to indicate that. Furthermore, note Col. 2, lines 38 – 44, Col. 12, lines 50 – 58 and database 601.

In fact, claim 1 is so broad because the limitations are just hanging out there without any time or sequence or specific order. For example, the claimed "authenticating..." and "replacing..." could possibly happen "last week", while the call is received "today". In addition, for example, no database is claimed and we do not know whether the caller or called party or a system changes the ID. And as claimed the "receiving a communication" could be read as going straight to the called party, the called party would see the first identifying information because the called party receives the call before any ID change happens. Therefore, what's the point?

Clearly, claims 1 – 2 are so broad as to read on Tannenbaum.

With respect to claim 3, Applicant's argument defies logic. Applicant states, "Claim 3 is further patentable over Tannenbaum as nowhere does Tannenbaum disclose that the second identifying information is received from a user... Instead, Tannenbaum discloses that any second identifying information is obtained from a database system." Of course the identifying information, both first and second identifying information is in a database, but how else did it get there except from the first user using a first communications device calling in and requesting to change his ID from home to the campaign institutions number or for any other specified number? The weakness of this argument comes clear after reading Applicant's specification at page 6, lines 3 – 7. See database 601 in Tannenbaum.

With respect to claim 4, Applicant argues that Tannenbaum does not disclose prompting the user to enter the second identifying information. The examiner agrees, however such a limitation is inherent or at least extremely obvious in Tannenbaum.

After calling into the system Tannenbaum states:

There can be security codes added to insure that improper users do not have their IDs changed. Alternatively, a caller could simply have a PIN which is used (and matched against a database of valid PINs) to change IDs. This would allow police officers (for example) to call from any phone and the recipient would "see" the ID of the police department. A database lookup, as shown in FIG. 6 would be used for such purposes. The ID change can be made for one call or for a campaign of calls, depending upon the authorization level established for the PIN.

After reading this would a reasonable person who knows anything about the art argue that the caller is prompted for his PIN even though the reference does not explicitly state such? The same is true with regard to the second identifying information. The caller calls into the system and is prompted for a PIN depending on the

authorization level he can change ID information. It is inherent that the user is at least asked what he wants to do, i.e., change IDs, add/delete phone numbers or other information in database 601. How else could the system know what you want to do? If one wants to change the ID, how else would the system know what to change it to unless the user is prompted to enter what the change is to be.

With respect to claims 10 – 13 and 15, most of Applicant's arguments have been covered in the arguments to claim 1. However, Applicant finally argues a main issue. Applicant states: "No call from an agent is first received, then authenticated and ID selection preformed, then connection of the same communication to a second communication device occurs in Tannenbaum." First, as stated above with respect to claim 1, the predictive dialer can act as a telephone switch and therefore the same communication is continued and terminating at the called party. However, even if Applicant could prevail on this point, that is, the connection has to be the same and that in Tannenbaum there are two or more separate connections, no such language is found in the claims. Applicant argues same connection but claims a communication. Applicant argues same connection when at best the claim is ambiguous as to whether the communication is the "same". Again, even accepting Applicants stand about the predictive dialer, Tannenbaum receives a communication to system 10 and the user is authenticated, IDs changed and connecting the communication from the first communication device to a second communication device is accomplished. The communication to the predictive dialer is that the user wants to talk with a targeted party. This communication is completed or connected once the two parties are

connected. Nothing in the claim indicates that the communication is real-time. Even if it did, as stated earlier, after reviewing the information in database 601 of Tannenbaum and understanding the predictive dialer has telephone switching capability, Tannenbaum also has real-time capabilities.

With respect to claim 14, Applicant states that "Tannenbaum does not receive custom ID information from a user." It is the user that changes the caller ID. No timing is recited in the claims and therefore, even if the user changed the user ID information last week, that still reads on the broad claim. Of course the changed ID came from the user, even if it was done at an earlier time, it came from the user using a first communication device. In both Applicant's device and Tannenbaum's device one must first call into a system to change the ID. Following Applicant's line of reasoning, Applicant's changed ID does not come from a user but from a database as pointed out above. Again, see page 6, lines 3 – 7 of the instant application.

With respect to claims 32 – 34, see arguments above with respect to claim 1. With respect to a router, the predictive dialer (with or without the telephone switch algorithm) could be a router even CMS 109 could be a router. If Applicant argues that these devices are not routers, a router is inherent in system 10. The call is inherently routed into the system, routed around in the system and out of the system.

Applicant has conveniently interpreted the reference in order to make species arguments. However, even if one accepts Applicant's interpretation of the Tannenbaum reference (that a predictive dialer (no telephone switching algorithm) is always used and therefore, no continuous connection)), Applicant's claims are so broad as to still read on

the Tannenbaum reference. The main issues are, is the connection one continuous connection and what is the timing of when the caller ID is changed, i.e., at the time of dialing ("on-the-fly") or at an earlier time, as stated with respect to the arguments above. Applicant argues these issues, but such limitations are not found in the claims. Even if such limitations were in the claims, Tannenbaum would still be used as a 102 reference (albeit a bit weaker) but definitely a strong 103.

In brief, the claimed steps lack timing, sequence or specific order in which the steps are preformed. For example, the claimed "authenticating..." and "replacing..." steps could possibly happen at any time (hours, days) before "receiving a communication".

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bill Deane whose telephone number is (703) 306-5838. In addition, facsimile transmissions should be directed to Bill Deane at facsimile number (703) 872-9306.

26Nov04


WILLIAM J. DEANE, JR.
PRIMARY EXAMINER